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EXAMINER

EKONG, EMEM

ART UNIT

PAPER NUMBER

2688

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/762,011	BENCO ET AL.	
	Examiner	Art Unit	
	EMEM EKONG	2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/21/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it includes legal phraseology, such as means. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S Patent No. 6,134,433 to Donald Joong (Joong et al.).

Regarding claim 1, Joong et al. discloses a method for a wireless network to forward an incoming call to a subscriber's primary mobile directory number on to a mobile fax directory number assigned to the subscriber, the method including the steps (col. 1 lines 24-41, and col. 2 line 60-col. 3 line 22):

a) associating the subscriber's mobile fax directory number with the subscriber's primary mobile directory number (col. 3 lines 8-22, and col. 5 lines 27-35);

b) determining that the incoming call is a fax call (col. 2 line 65-col. 3 line 5, col. 3 lines 11-13, and col. 5 lines 49-55); and

c) forwarding the incoming call to the subscriber's mobile fax directory number (col. 3 lines 15-18, and col. 5 lines 53-56).

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Regarding claim 2, Joong et al. discloses the method set forth in claim 1, before step b), further including the step: d) receiving the incoming call from a calling party to the subscriber's primary mobile directory (col. 3 lines 8-13).

Regarding claim 16, Joong et al. discloses a wireless network for forwarding an incoming call to a subscriber's primary mobile directory number on to a mobile fax directory number assigned to the subscriber, the wireless network including:

means for associating the subscriber's mobile fax directory number with the subscriber's primary mobile directory number (col. 3 lines 8-13);

means for determining that the incoming call is a fax call (col. 3 lines 8-13); and

means for forwarding the incoming call to the subscriber's mobile fax directory number (col. 3 lines 18-20).

Regarding claim 17, Joong et al. discloses the wireless network set forth in claim 16, further including: means (O-MSC) for receiving the incoming call from a calling party to the subscriber's primary mobile directory (col. 4 lines 29-31, col. 5 lines 27-30, and col. 6 lines 47-49).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 3–5, are rejected under 35 U.S.C. 103(a) as being unpatentable over Joong et al. in view of U.S Patent No. 6,151,137 to Robert F. Henrick (Henrick).

Regarding claim 3, Joong et al. discloses the method set forth in claim 1, however fails to disclose further including the step: d) determining if the incoming call forwarded to the subscriber's mobile fax directory number was connected; e) if the

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incoming call was connected, determining if the fax was completed; and f) if the fax was completed, communicating a success status message to the calling party.

Henrick discloses the method further including the step: d) determining if the incoming call forwarded to the subscriber's mobile fax directory number was connected (col. 4 line 61-col.5 line 40);

e) if the incoming call was connected, determining if the fax was completed (col. 5 line 33-col. 6 line 9) ; and f) if the fax was completed, communicating a success status message to the calling party (col. 6 lines 1-9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Joong et al. with teachings of Henrick for the purpose of providing status confirmation to the calling party.

Regarding claims 4, and 5, Joong et al. discloses the method set forth in claim 3, however fails to disclose further including the step: g) if the incoming call was not connected, communicating a fail status message to the calling party (claim 4);

further including the step: g) if the fax was not completed, communicating a fail status message to the calling party (claim 5).

Henrick discloses further including the step: g) if the incoming call was not connected, communicating a fail status message to the calling party (reads on claim 4) (col. 5 lines 16-32);

further including the step: g) if the fax was not completed, communicating a fail status message to the calling party (reads on claim 5)(col. 6 lines 1-9).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Joong et al. with teachings of Henrick for the purpose of providing status confirmation to the calling party.

7. Claims 6, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joong et al. in view of Henrick as applied to claim 3 above, and further in view of U.S Patent No. 6,404,513 B1 to John Stewart Denker (Denker).

Regarding claim 6, the combination of Joong et al. and Henrick discloses the method set forth in claim 3, however, the combination fails to disclose wherein the success status message includes a number of pages received.

Denker discloses wherein the success status message includes a number of pages received (col. 4 line 66-col. 5 line 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination with Denker for the purpose of including number of pages in the success status message in order to confirm that all pages sent were received.

Regarding claim 12, Joong et al. discloses a method for a wireless network to forward an incoming call to a subscriber's mobile fax directory number, the method including the steps:

- a) associating the subscriber's mobile fax directory number with a primary mobile directory number assigned to the subscriber (col. 1 lines 24-41, and col. 2 line 60-col. 3 line 22);
- b) receiving the incoming call from a calling party to the subscriber's primary mobile directory (col. 3 lines 8-22, and col. 5 lines 27-35);
- c) determining that the incoming call is a fax call (col. 3 lines 11-13, and col. 5 lines 49-55);
- d) forwarding the incoming call to the subscriber's mobile fax directory number (col. 3 lines 15-18, and col. 5 lines 53-56).

However, Joong et al. fails to disclose, e) determining if the incoming call forwarded to the subscriber's mobile fax directory number was connected;

- f) if the incoming call was connected, determining if the fax was completed; and
- g) if the fax was completed, communicating a success status message to the calling party, wherein the success status message includes the number of pages received.

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Henrick discloses a method for e) determining if the incoming call forwarded to the subscriber's mobile fax directory number was connected;

f) if the incoming call was connected, determining if the fax was completed (col. 5 line 33-col. 6 line 9); and

g) if the fax was completed, communicating a success status message to the calling party (col. 6 lines 1-9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Joong et al. with Henrick for the purpose of providing status information to calling party.

However, Henrick fails to disclose wherein the success status message includes the number of pages received.

Denker discloses wherein the success status message to caller includes a number of pages received (col. 4 line 66-col. 5 line 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of combination of Joong et al. and Henrick with teachings of Denker for the purpose of including number of pages delivered to the subscriber in the status message.

Regarding claim 18, Joong et al. discloses the wireless network as set forth in claim 16, however fails to disclose further including: means for determining if the incoming call forwarded to the subscriber's mobile fax directory number was connected; means for determining if the fax was completed; and means for communicating a

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success status message to the calling party, wherein the success status message includes a number of pages received.

Henrick discloses the wireless network further including: means for determining if the incoming call forwarded to the subscriber's mobile fax directory number was connected; means (double dialer) for determining if the fax was completed; and means (POP 103) for communicating a success status message to the calling party (col. 4 line 30- col. 6 line 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Joong et al. with teachings of Henrick for the purpose of providing status confirmation to the calling party.

However, Henrick fails to disclose wherein the success status message includes a number of pages received.

Denker discloses wherein the success status message includes a number of pages received (col. 4 line 66-col. 5 line 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination with Denker for the purpose of including number of pages in the success status message in order to confirm that all pages sent were received.

8. Claims 7, 8, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joong et al. in view of Henrick as applied to claims 3, and 12 above, and further in view of U.S Patent No. 6,718,178 B1 to Thomas M. Sladek (Sladek et al.), and further in view of Denker.

Regarding claims 7 and 8, the combination of Joong et al. and Hendick discloses the method set forth in claim 3, however fails to disclose further including the step: g) if the fax was completed, communicating a text message to the subscriber's primary mobile directory number via a text messaging system, wherein the text message indicates that a fax was received at the subscriber's mobile fax directory number (claim 7).

Sladek et al. discloses further including the step: g) if the fax was completed, communicating a text message to the subscriber's primary mobile directory number via a text messaging system, wherein the text message indicates that a fax was received at the subscriber's mobile fax directory number (reads on claim 7)(col. 8 line 64-col. 9 line 21, col. 9 lines 39-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of the combination with Sladek et al. for the purpose notifying the subscriber using a text messaging system.

However, Sladek et al. fails to specifically disclose wherein the text message includes a number of pages received (claim 8).

Denker discloses wherein success status message to calling party includes a number of pages received (col. 4 line 66-col. 5 line 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the combination of Joong et al.; Henrick, and Sladek et al. with Denker's success status message to caller by including number of pages received in the text message to subscriber for the purpose of the notification

including number of pages received.

Regarding claim 15, the combination of Jong et al., Henrick, and Denker disclose the method set forth in claim 12 above, however fails to disclose further including the step: h) if the fax was completed, communicating a text message to the subscriber's primary mobile directory number via a text messaging system, wherein the text message indicates that a fax was received at the subscriber's mobile fax directory number and includes the number of pages received.

Sladek et al. discloses further including the step: h) if the fax was completed, communicating a text message to the subscriber's primary mobile directory number via a text messaging system, wherein the text message indicates that a fax was received at the subscriber's mobile fax directory number (col. 8 line 64-col. 9 line 21, col. 9 lines 39-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination with Sladek et al. for the purpose notifying the subscriber using a text messaging.

However, Sladek et al. fails to disclose includes the number of pages received in the text message.

Denker discloses wherein success status message to caller includes a number of pages received (col. 4 line 66-col. 5 line 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the combination with Denker's success status

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message to calling party by including number of pages in the text message to subscriber for the purpose of the notification including number of pages received.

Regarding claim 19, Joong et al. discloses the wireless network set forth in claim 16, however fails to disclose further including: means for communicating a text message to the subscriber's primary mobile directory number via a text messaging system, wherein the text message indicates that a fax was received at the subscriber's mobile fax directory number.

Sladek et al. discloses wireless network further including: means for communicating a text message to the subscriber's primary mobile directory number via a text messaging system, wherein the text message indicates that a fax was received at the subscriber's mobile fax directory number (col. 8 line 64-col. 9 line 21, col. 9 lines 39-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of the combination with Sladek et al. for the purpose notifying the subscriber of fax call using a text messaging.

However, Sladek et al. fails to disclose the text message includes a number of pages received.

Denker discloses wherein success status message to calling party includes a number of pages received (col. 4 line 66-col. 5 line 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the combination with Denker's success status

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message to calling party by including number of pages in the text message for the purpose of the notification to the subscriber including number of pages received.

9. Claims 9-11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joong et al. in view of U.S. Patent No. 6,188,758 B1 to Soren Christensen (Christensen et al.).

Regarding claims 9-11, Joong et al. discloses the method set forth in claim 1.

However, Joong et al. fails to disclose, before step c), further including the step: d) connecting the incoming call to the subscriber's primary mobile directory number; e) waiting for a control message via the subscriber's primary mobile directory number instructing the wireless network to forward the incoming call to the subscriber's mobile fax directory number; and f) receiving the control message via the subscriber's primary mobile directory number instructing the wireless network to forward the incoming call to the subscriber's mobile fax directory number (claim 9);

the control message is automatically initiated when the incoming call is connected to the subscriber's primary mobile directory number (claim 10); and

the control message is initiated by activation of at least one control on a mobile device associated with the subscriber's primary mobile directory number (claim 11).

Christensen et al. discloses the method, before step c), further including the step:

d) connecting the incoming call to the subscriber's primary mobile directory number (abstract, see figures 1 and 2, col. 1 lines 21-30, col. 2 lines 43-66, col. 3 lines 59-63);

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e) waiting for a control message(signaling) via the subscriber's primary mobile directory number instructing the wireless network to forward the incoming call to the subscriber's mobile fax directory number(col. 3 line 59-col. 3 line 21); and

f) receiving the control message (signaling) via the subscriber's primary mobile directory number instructing the wireless network to forward the incoming call to the subscriber's mobile fax directory number (reads on claim 9) (col. 4 lines 23-30);

the control message (signaling) is automatically initiated when the incoming call is connected to the subscriber's primary mobile directory number (reads on claim 10) (col. 1 lines 35-45, and col. 4 lines 31-41);

the control message (signaling) is initiated by activation of at least one control on a mobile device associated with the subscriber's primary mobile directory number (reads on claim 11) (col. 3 lines 1-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Joong et al. with the control message (signaling) of Christensen et al. for the purpose of an individual user being reached on a number of different terminals, depending on the time of day and the type of service desired, for example, a user may be reached at a telephone in a business network at work, at a mobile telephone that is switched on only part of the time. At any time, the user can receive telefax on his personal number. The fax will be routed to a telefax machine in accordance with the user's temporary or permanent fax number.

Regarding claim 20, Joong et al. discloses the wireless network set forth in claim 16, however fails to disclose further including: means for connecting the incoming call to the subscriber's primary mobile directory number; means for waiting for a control message via the subscriber's primary mobile directory number instructing the wireless network to forward the incoming call to the subscriber's mobile fax directory number; and means for receiving the control message via the subscriber's primary mobile directory number instructing the wireless network to forward the incoming call to the subscriber's mobile fax directory number.

Christensen et al. discloses further including: means (SSP 5) for connecting the incoming call to the subscriber's primary mobile directory number; means (SSP 5) for waiting for a control message via the subscriber's primary mobile directory number instructing the wireless network to forward the incoming call to the subscriber's mobile fax directory number (see figures 1 and 2, and col. 3 line 45-col. 4 line 30); and

means (SSP 5) for receiving the control message via the subscriber's primary mobile directory number instructing the wireless network to forward the incoming call to the subscriber's mobile fax directory number (col. 4 lines 20-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Joong et al. with the control message (signaling) of Christensen et al. for the purpose of an individual user being reached on a number of different terminals, depending on the time of day and the type of service desired.

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10. Claims 13 and 14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Joong et al. in view of Henrick.

The combination of Joong et al discloses the method set forth in claim 12, however fails to disclose further including the step: h) if the incoming call was not connected, communicating a fail status message to the calling party (claim 13);

further including the step: h) if the fax was not completed, communicating a fail status message to the calling party (claim 14);

Henrick discloses further including the step: h) if the incoming call was not connected, communicating a fail status message to the calling party (reads on claim 13) (col. 4 line 30-col. 5 line 20);

further including the step: h) if the fax was not completed, communicating a fail status message to the calling party (reads on claim 14) (col. 5 line 33-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Joong et al. with Henrick for the purpose of providing status information to calling party.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to forwarding fax call:

U.S. Pat. No. 6,115,461 to Robert J. Baiyor et al.

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International Pub. No. WO 99/01004 to Keijo Palviainen

U.S. Pat. No. 6590969 B1 to Marco Johannes Peters et al..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMEM EKONG whose telephone number is 571 272 8129. The examiner can normally be reached on 8-5 Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH FEILD can be reached on 571 272 4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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